REMARKS

In the Office Action dated December 5, 2005, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121, alleging that the subject matter defined by the claims of the present invention represents the following two separate and distinct inventions:

I. Claim 40, drawn to a DNA construct, classified in class 435, subclass 320.1, for example.

II. Claims 41-45, drawn to a transgenic plant comprising a nucleic acid molecule, classified in class 800, subclass 298, for example.

In addition, the Examiner states that upon election of Group I or Group II, a single coding sequence must also be elected.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claim 40, drawn to a DNA construct, and SEQ ID NO: 7. Applicants further respectfully submit that SEQ ID NO: 8 represents the amino acid sequence encoded by SEQ ID NO: 7 and should be included in the examination. Applicants reserve the right to file a divisional application directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added). The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized. In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement.

Specifically, the Examiner alleges that Groups I and II are distinct products, because the DNA construct of Group I is classified separately from, and differs in structure, function and use from, the transgenic plant comprising a nucleic acid molecule of Group II.

Applicants respectfully submit that the DNA construct of Group I is characterized as capable of reducing expression of an endogenous gene encoding a flavonoid 3'-hydroxylase (F3'H) in a plant. A key element of the DNA construct of Group I resides in the specified nucleotide acid sequences contained in the DNA construct. The transgenic plant of Group II, characterized as having tissue exhibiting altered color, contains the same specified nucleotide acid sequences as the DNA construct of Group I. In fact, the DNA construct of Group I is made for producing the transgenic plant of Group II , and the altered color in the transgenic plant is the result of reducing the expression of an endogenous gene encoding a flavonoid 3'-hydroxylase via one of the specified nucleotide acid sequences. Therefore, Applicants respectfully submit that Group I and Group II are clearly related under a single inventive concept. Groups I and II are simply different aspects of a single invention. The different sequences recited in the claims are also related to each other as F3'H coding sequences or fragments thereof from various plant species.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such

allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Finally, Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of the defined two groups and the various sequences, one from the other, as presented by the Examiner.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

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